

### Remarks

Applicants wish to thank the Examiner for the interview of January 4, 2008 where Examiner Reidel agreed to wait until receipt of this paper and attached declarations under 37 C.F.R. § 1.131 before responding to Applicants' amendments filed on October 23, 2007.

Claims 1-5, 15-23 and 30-38 of the Application stand rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by U.S. Patent Application No. 2002/0138768 to Murakami et al. (hereafter Murakami). The declarations attached hereto establish that the claimed subject matter antedates Murakami. As such, Applicant respectfully requests removal of Murakami as a reference and withdrawal of the rejections based thereon.

#### Murakami is not Available as a Reference Under § 102(e)

Section 102 states in part:

“a person shall be entitled to a patent unless: ...  
“(e) the invention was described in (1) an application for patent ... by another filed in the United States before the invention by the applicant for patent...” 35 U.S.C. § 102; emphasis added.

Murakami is not available as a reference since it was not filed before the invention of the present Application.

Prior invention may be shown by establishing 1) conception of the invention prior to the effective date of the reference, and 2) due diligence from “a time just prior to the date of the reference up to the date of an actual reduction to practice or up to the date of filing his or her application.” MPEP § 715.07(III).

The effective date of a § 102(e) reference is the application filing date. In re Bartfeld, 925 F.2d 1450 at 1451 (Fed. Cir. 1991). The filing date of Murakami is March 22, 2001.

*The Claimed Subject Matter was Conceived Prior to the Effective Date of Murakami and Dilligently Reduced to Practice from Time Just Prior to the Date of the Reference up to the Filing Date of the Application*

Applicants have provided herewith two sets of declarations under 37 C.F.R. § 1.131 to establish that the claimed subject matter was conceived prior to the effective date of Murakami, and diligently reduced to practice from just prior to March 22, 2001, to the filing date of the application one day later on March 23, 2001.

*Declaration of Inventors, J. Spencer Grant, Rick V. Murakami, Clark T. Hinton, and Matthew W. Pettit.*

Per MPEP § 715.04(I)(A), Applicants have attached hereto, declarations of “[a]ll the inventors of the subject matter claimed:” J. Spencer Grant; Rick V. Murakami; Clark T. Hinton; and Matthew W. Pettit. All of the inventors declare that the claimed subject matter was conceived at least prior to March 22, 2001.

In support of the inventor’s declarations, Applicants have provided documentary evidence per MPEP § 715.07, which states that evidence in the form of, *inter alia*, “attached sketches” and “supporting statements by witnesses” may be relied upon to establish the date of conception and invention. The inventors’ declarations reference sketches of the invented subject matter. Each of the inventors declares that the attached drawings and sketches were produced at least prior to March 22, 2001.

In addition, a letter from patent counsel is attached to each declaration. The letter states that a draft of the application and associated drawings were provided to the inventors for their review. Each of the inventors declares that this letter was received at least prior to March 22, 2001. This documentary evidence, along with the statements of the inventors themselves, clearly establishes that the claimed subject matter was conceived in this country at least prior to March 22, 2001.

*Declaration of Mr. Michael M. Conger*

In addition to the inventors' declarations, Applicants have attached hereto a declaration of the attorney who prepared the Application, Mr. Michael M. Conger. As detailed in Mr. Conger's Declaration, the claimed subject matter was conceived in this country at least before March 21, 2001, prior to the effective date of Murakami.

Mr. Conger prepared and filed the present Application. In the attached declaration, Mr. Conger states, and the included billing invoices prepared by Mr. Conger's firm at the time, Kirton & McConkie, establish that Mr. Conger finalized drafting of the Application on March 21, 2001. This is further evidence that the Application was conceived before the effective date of Murakami. The application was filed two days later on March 23, 2001.

*The Claimed Subject Matter was Diligently Reduced to Practice from Just Prior to the Effective Date of Murakami to the Filing Date of the Application*

To antedate a reference, an applicant may show conception prior to the effective date of the reference and diligence in reduction to practice from a time, "just

prior to the date of the reference continuously up to the date of... filing his or her application.” MPEP § 715.07(III).

The effective date of Murakami is March 22, 2001, and the filing date of the Application is March 23, 2001. As such, in accordance with MPEP 715.07(III)(C), Applicants need only show due diligence for the one-day period from March 22, 2001, to March 23, 2001<sup>1</sup>.

The one-day gap between finalization of the Application and filing clearly falls within the reasonable limits of diligence. For example, in Sletzinger v. Lincoln, the court held that a two-day delay between execution of the complete patent application and its mailing to the Patent Office was of, “such short duration” that it was an “inevitable minor interruption[] accompanying the conduct of patent prosecution ... within the limits of reasonable diligence.” Sletzinger v. Lincoln, 410 F.2d 808 (CCPA 1969); emphasis added. The one-day gap in this case, half as long as the Sletzinger gap, is an even clearer example of an “inevitable minor interruption” accompanying the conduct of patent prosecution. As such, the one-day delay between the effective date of Murakami and the filing of the Application does not represent a failure to diligently reduce the claimed subject matter to practice. Moreover, Mr. Conger’s declaration states that he was working to finalize the Application in the days leading up to the filing. See Mr. Conger’s declaration ¶¶ 3 and 4. As such, Mr. Conger’s

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<sup>1</sup> “...37 C.F.R. 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter.... (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).” MPEP § 715.07(III); *Also see* 37 C.F.R. 1.131(b).

declaration represents evidence of diligent efforts to reduce the invention to practice by filing the Application.


**Conclusion**

Murakami should be removed as a reference because Applicants have established that the claimed subject matter was conceived in this country at least prior to the filing date of Murakami (March 22, 2001) and that the one-day gap between the effective date of Murakami and the filing date of the Application does not represent failure to diligently reduce the invention to practice. As such, Applicants respectfully request that Murakami be removed as a reference and that the claim rejections based thereon be withdrawn.

Respectfully submitted,

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